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10/687,534	10/15/2003	Robert H. Kondrk	101-P291/P3157US1	7744

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EXAMINER	
REFAI, RAMSEY	

ART UNIT	PAPER NUMBER
3627	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/687,534	KONDRK ET AL.	
	Examiner	Art Unit	
	RAMSEY REFAI	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46 and 50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-46 and 50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06/04/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Responsive to Request for Continued Examination (RCE) filed June 4, 2009. Claims 1, 6, 11, 21, 30, and 43 have been amended. Claim 50 is new. Claims 1-46 and 50 are pending.

Response to Arguments

1. Applicant's arguments have been fully considered but they are not persuasive.

- In the remarks, the Applicant argues with substance:

Argument A: *"Galuten et al is not offering tools or assistance to users that submitting media collections to media distribution site for distribution"*

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *offering tools or assistance to users that submitting media collections to media distribution site for distribution*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Galuten et al does teach the distributors submitting the content to the production system **(see at least fig 2).**

Argument B: *"Galuten does not teach or suggest that its content elements could be collections"*

In response, the Examiner respectfully disagrees. Galuten teaches that songs can be bundled up into a collection such as an album **(see at least column 3, lines 41-55).** Therefore Galuten et al meets the scope of the claimed invention.

Argument C: *"Applicant makes a seasonal challenge to the taking of Official Notice"*

In response, the Examiner asserts that the Applicant has not adequately traversed the Official Notice taken in the previous action. " *To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art*." MPEP 2144.03c. **The common knowledge or well-known in the art statement is taken to be admitted prior art because the traverse was inadequate. MPEP 2144.03c**

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-30 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 11-13, 16, 18, 21, 23-29, 31-34, 36, 39-41, 44-46, and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Galuten et al (US Patent 7,209,892).

5. As per claim 1, Galuten et al teach a method for submission of a media collection to a media distribution site, said method comprising:

obtaining metadata for the media collection **(see at least column 3, lines 8-15, 41-50; metadata is provided)**

identifying media content for a plurality of media items to be included in the media collection, the media content being imported from a media source, each of the media items including a different audio track **(see at least column 3, lines 41-50; album including a plurality of songs to form a collection/album)**;

converting the identified media content for the plurality of media items into compressed media files, said converting encodes the media content for each of the media items into a compressed audio format **(see at least column 3, lines 50-52; every content element is compressed);**

obtaining metadata for the identified media content **(see at least column 3, lines 8-15, 41-50)**;

forming an electronic package of the media collection **(see at least column 3, lines 41-50; album including a plurality of songs to form a collection/album)**, the electronic package including at least the compressed media files and the metadata associated with the media collection and the identified media content **(see at least column 3, lines 50-52; every content element is compressed)**; and

thereafter electronically transmitting the electronic package to the media distribution site, thereby submitting the media collection to the media distribution site for subsequent distribution **(see at least column 3, lines 55-61, column 6, lines 40-66, abstract, production system receives content and provides mechanism for distribution).**

6. As per claim 2, Galuten et al teach wherein the metadata for the media collection obtained includes at least descriptive media collection information **(see at least column 3, lines 8-11).**

7. As per claim 3, Galuten et al teach wherein the descriptive media collection information includes, for the media collection, at least a title, an artist, a genre, a label name, copyright information, release information, and a numerical identifier **(see at least column 3, lines 8-11, 41-46).**

8. As per claim 4, Galuten et al teach wherein the descriptive media collection information further includes an image to be used as artwork for the media collection **(see at least column 3, lines 8-11, 41-46).**

9. As per claim 5, Galuten et al teach wherein the metadata for the media collection is entered by a user **(see at least column 3, line 11-14)**

10. As per claim 6, Galuten et al teach wherein the audio tracks pertain to songs, and wherein said converting encodes the media content for each of the songs into a compressed audio format **(see at least column 3, lines 41-52).**

11. As per claim 11, Galuten et al teach wherein at least one of the media items is a multimedia item **(see at least column 3, lines 10-11).**

12. As per claim 12, Galuten et al teach wherein the metadata for the identified media content includes at least descriptive media item information for each of the media items of the identified media content **(see at least column 3, lines 8-11, 41-46)**.

13. As per claim 13, Galuten et al teach wherein the descriptive media item information includes, for the corresponding media item, at least a title, an artist, a genre, track number, a

label name, copyright information, and a numerical identifier **(see at least column 3, lines 8-11, 41-46)**.

14. As per claim 16, Galuten et al teach wherein the metadata for the identified media content is entered by a user **(see at least column 3, line 11-14)**.

15. As per claim 18, Galuten et al teach wherein a second portion of the metadata for the identified media content is entered by a user **(see at least column 3, lines 8-11, 41-46)**.

16. As per claim 21, Galuten et al teach wherein the electronic package of the media collection comprises a folder of files, one of the files is a markup language file containing at least the metadata; another of the files is an image file for artwork associated with the media collection, and a plurality of other of the files are compressed audio files **(see at least column 29, lines 50-67, column 31, lines 32-51, abstract)**.

17. As per claim 23, Galuten et al teach wherein said transmitting operates to electronically transmit the electronic package to the media distribution site over the Internet **(see at least abstract)** using encryption **(see at least column 3, line 51)**.

18. As per claim 24, Galuten et al teach wherein said method further comprises: receiving the electronic package at the media distribution site; parsing the electronic package to retrieve components from the electronic package, the components including at least the identified media content in the compressed media format, the metadata for the media collection and the

metadata for the at least one media item; and storing the components into a media distribution database **(see at least column 3, lines 40-61, column 30, lines 10-40)**.

19. As per claim 25, Galuten et al teach wherein said method further comprises: rendering the media collection and the media items thereof available for online purchase at the media distribution site **(see at least column 7, lines 1-4, column 8, lines 39-53, 66-67)**.

20. As per claim 26, Galuten et al teach wherein said method further comprises: rendering the media collection and the media items thereof available for online purchase at the media distribution site **(see at least column 7, lines 1-4, column 8, lines 39-53, 66-67)**.

21. As per claim 27, Galuten et al teach wherein said method is performed by an application program **(see column 6, lines 41-66).**

22. As per claim 28, Galuten et al teach wherein, when the application program performs said obtaining of the metadata for the media collection and said obtaining of the metadata for the identified media content, a user interacts with the application program **(see column 6, lines 41-66)**.

23. As per claim 29, Galuten et al teach wherein the user is a representative for an independent recording label, and wherein said application program facilitates the independent recording label in submission of the media collection to the media distribution site for subsequent online distribution **(see at least column 3, line 14)**.

24. As per claim 39, Galuten et al teach wherein the media distribution site is an online media distribution site **(see at least abstract).**

25. Claims 31-34, 36, 40-41, 44-46, and 50 contain similar limitations as claims 1, 5-7, 12, 21, 23, 25 and 29 and are therefore rejected under the same rationale.

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

27. Claims 14, 17, 19, 35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galuten et al.

28. As per claims 14, 19, and 37 Galuten et al fail to explicitly teach wherein *the metadata for the identified media content includes an indication as to whether the identified media content is available for sale*. However, it would have been obvious to one of ordinary skill in the art to modify the teaching of Galuten et al to include such feature because doing so would allow for an artist to authorize the sale of the content by entering the information as descriptive data.

29. As per claim 17, Galuten et al fail to explicitly teach wherein *a first portion of the metadata for the identified media content is obtained from the metadata for the media collection*.

However, it would have been obvious to one of ordinary skill in the art to include this feature in Galuten et al because doing so would create a way to associate the media with the media file in Galuten et al by associating the metadata such as including the title of the media file in the title of the media.

30. As per claim 35, Galuten et al fail to teach wherein *the media source is a compact disc.* However, it would have been obvious to one of ordinary skill in the art to include this feature in Galuten et al because doing so would allow an artist to upload his music to the content manager directly from a compact disc.

31. Claims 7-10, 22, 30, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galuten et al in view of "Official Notice".

32. As per claims 7-10, Galuten et al fails to explicitly teach wherein the compressed audio format is MPEG based, MPEG4 based, Advanced Audio Coding (AAC), MP4, M4 or M4a. However, "Official Notice" is taken that the concept and advantages of such formats are well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to include any one of these audio formats in Galuten et al because doing so would allow for the media files to be efficiently communicated via the Internet **(see paragraph [0005] of Applicant's specification).**

The Applicant has not adequately traversed the Official Notice taken in the previous action. " *To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.*" MPEP 2144.03c. **The common**

knowledge or well-known in the art statement is taken to be admitted prior art because the traverse was inadequate. MPEP 2144.03c

33. As per claim 22, Galuten et al teach wherein the markup language file is an XML file **(see at least column 29, line 61)**, but fail to *explicitly* teach wherein the image file is a *JPEG file*, and the compressed audio files are *MPEG4 based*. However, "Official Notice" is taken that both the concept and advantage of a JPEG file and MPEG4 are well known in the art as evidenced by Marsh **(US 7,073,193, see at least column 6, lines 35-48, column 51, lines 25-37)** and the Applicant's specification **(see paragraph [0005])**. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to include these features in Galuten et al because doing so would allow for the media file to be efficiently communicated via the Internet.

The Applicant has not adequately traversed the Official Notice taken in the previous action. " *To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.*" MPEP 2144.03c. **The common knowledge or well-known in the art statement is taken to be admitted prior art because the traverse was inadequate. MPEP 2144.03c**

34. Claim 42 contains similar limitations as claim 22 and therefore is rejected under the same rationale.

35. As per claim 30, Galuten et al fail to teach determining whether the electronic package should be transmitted or queued; queuing the electronic package when said determining

determines that the electronic package should be queued; and transmitting the electronic package to the media distribution site when said determining determines that the electronic package should be transmitted. However, "Official Notice" is taken that the concept and advantage of determining whether to transmit or queue data and queuing a transmission until transmission is possible is well known in the art as evidenced by **Tang et al (US 2003/0074465)** and **Blackwell et al (US 6,085,253).** It would have been obvious to one of ordinary skill in the art to include this feature in Galuten et al because doing so would allow data file to be queued when the server or the bandwidth is unavailable for uploading the data file. The Applicant has not adequately traversed the Official Notice taken in the previous action. " *To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.*" MPEP 2144.03c. **The common knowledge or well-known in the art statement is taken to be admitted prior art because the traverse was inadequate. MPEP 2144.03c**

36. Claim 43 contains similar limitations as claim 30 and therefore is rejected under the same rationale.

37. Claims 15, 20, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galuten et al in view of Marsh (US 7,073,193).

38. As per claim 15, Galuten et al fail to *explicitly* teach wherein the descriptive media item information further includes *a parental advisory*. However, in the same field of endeavor, Marsh teaches where the metadata for media content such as songs **(column 2, lines 30-32)** can be

censor parental ratings **(see column 84, lines 11-20, fig 22).** It would have been obvious to one of ordinary skill in the art to combine the features of Marsh with Galuten et al because doing so would notify customers of the nature of the media content.

39. As per claim 20, Galuten et al fail to explicitly teach *wherein the metadata for the imported media content includes a parental advisory.* However, in the same field of endeavor, Marsh teaches that metadata for media content such as songs **(column 2, lines 30-32)** can include censor parental ratings **(see column 84, lines 11-20, fig 22).** It would have been obvious to one of ordinary skill in the art to combine the features of Marsh with Galuten et al because doing so would notify customers of the nature of the media content.

40. As per claim 38, Galuten et al fail to *explicitly* teach wherein the metadata for the identified media content includes *a parental advisory indication.* However, in the same field of endeavor, Marsh teaches that metadata for media content such as songs **(column 2, lines 30-32)** can include censor parental ratings **(see column 84, lines 11-20, fig 22).** It would have been obvious to one of ordinary skill in the art to combine the features of Marsh with Galuten et al because doing so would notify customers of the nature of the media content.

Conclusion

The prior art made of record and not relied upon, which is considered pertinent to applicant's disclosure, are cited in the Notice of Reference Cited form (PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMSEY REFAI whose telephone number is (571)272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai
August 2, 2009
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